

## REMARKS

Initially, Applicant expresses appreciation to the Examiner for the courtesies that were extended during the in person interview with Applicant's attorney on December 12, 2006. The amendments and remarks made by this paper are consistent with the interview discussions.

By this paper, claims 1-3, 5, 9, 14 and 18-19 have been amended and new claims 24-29 have been added, such that claims 1-10, 12-15, 18-20 and 22-29 remain pending, of which claims 1, 10, 14, 15, 18, 19, 22 and 23 are the only independent claims at issue.<sup>1</sup>

In the Final Office Action mailed July 28, 2006, claims 1-10, 12-15, 18-20 and 22-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Fields et al. (US 6,338,059) hereinafter Fields.<sup>2</sup> Notably, Fields was originally used by the Examiner to reject the claims in the First Office Action, mailed September 12, 2003. In response to that First Office Action, Amendment A was presented, which distinguished the claimed invention from Fields. Later, new grounds of rejection were used to reject the claims in five subsequent Office Actions. All of the new grounds of rejection, which were raised in those subsequent five Office Actions, have been overcome in the corresponding prosecution.

Fields is now being cited, again, as the sole basis for rejecting all of the pending claims. However, as discussed and as generally agreed to during the interview, Fields clearly fails to teach or suggest the claimed invention for at least the reasons presented during the interview, some of which are summarized herein, as well as for the reasons that were previously presented in Amendment A.

As discussed during the interview, the present invention is generally directed towards unique and novel embodiments for performing searching. The embodiment recited in

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<sup>1</sup> Support for the claim amendments and new claims, which was reviewed during the interview, includes at least the disclosure found in ¶¶ 2, 4, 6-9, 21, 23, 27-28, 32-33 & 37 of the Specification (numbered as originally filed). It will be appreciated that the amendments to the claims have been made to clarify and explicitly recite certain limitations that were already present in the claims. (In particular, the claims already recited the involvement of two different applications. This amendment merely clarifies in more explicit terms that the different applications are of a different type—e.g., they are different in at least some way). Accordingly, if there is any difference in functionality, or otherwise, between the applications, they should be construed as different types (even if they could also be construed as being of a same type in some alternative way). With regard to this element, it will also be appreciated that the different applications can also comprise different embedded applications within a single application (see claim 29 & ¶32). In the embodiment of claim 19, at least one application is a browser and one application is an application other than a browser.

<sup>2</sup> Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

independent claim 1, for example, recites a method that includes selecting search terms within a first application and performing a search based on the search terms with a second application. As noted, the second application is of a different type than the first application. The computer also remains in a context of the first application without initiating display of the second application to the user. The search results obtained by the second application are then returned to the first application in one or more different ways, including copying, pasting, deleting, saving and/or displaying the search results.

Independent claims 14, 18 and 19 recite similar methods to the method recited in claim 1, but focus on more specific embodiments in which it is explicit that the user views the search results within the first application (claim 14), wherein the second application operates in a background that is not displayed to the user (claim 18), and wherein the second application is a browser type application (claim 19).

The only remaining independent claims (10, 15, 22 and 23) are computer program product claims that include computer-readable media having computer-executable instructions for implementing the methods recited in claims 1, 14, 18 and 19, respectively.

Fields, the only art cited in the rejection of the claims, is generally directed towards embodiments for enabling real time creation of hyperlinks (Abstract). In Fields, words that are selected from a first displayed web page (that are not already hyperlinks) are searched and presented to a user in a second web page. (Abstract, Col. 3, ll. 23-44). While Fields does disclose that different servers or computing systems can host the different web pages that are presented to the user, it is also clear that the web pages of Fields correspond to applications of the same type (e.g., Internet browsers). In no instance does Fields disclose or suggest that a first application, from which search terms are selected, includes an application type that is different than the type of the first application, as recited, for example in the pending claims, and particularly as recited in combination with the other recited claim elements. The foregoing is particularly true when considering the more specific embodiments, such as recited in claim 19, for example, wherein the application type includes an application type other than a browser, or wherein the application type includes a word processor or a spreadsheet application type (see claim 28.)

For at least the foregoing reasons, it was generally settled during the interview that the pending claims are distinguished from Fields and that the rejections of record appear to be overcome (subject, of course, to an updated search and further consideration).

In view of the foregoing, Applicant respectfully submits that all the rejections to the claims, including the dependent claims, are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice.<sup>3</sup> In fact, to the contrary, it will be noted that Applicant specifically disagrees with many of the assertions made in the last Office Action (as discussed during the interview). Applicant also submits that many of the dependent claims present additional clarifications that even further distinguish the claimed invention from the cited art.

For example, Fields clearly fails to disclose or suggest any embodiment in which search terms are automatically selected, as recited in claim 3, for example. The Examiner cites to Col. 3, ll. 45-67 and Col. 4, ll. 1-13 for this teaching. However, this disclosure merely indicates that a form can be provided for enabling a user to select terms and search engines to use in the search. In fact, it will be noted that this disclosure in Fields actually teaches away from the claimed 'automatic selection of search terms' by disclosing an embodiment that appears to require the manual entry of search terms into a form field. Clearly, this disclosure in Fields fails to provide any teaching or suggestion regarding the automatic selection of search terms.

Fields also fails to disclose or suggest any embodiment in which a limit is placed on the number of search results to be returned (see, for example, claim 20). In rejecting claim 20, the Examiner cites to Col. 6, ll. 25-33 and Col. 7, ll. 24-51 of Fields. However, this disclosure refers to an embodiment in which an intermediary server can present the search results in a new web page and wherein the new web page data can be "recast" in a template having the same look and feel as the previous web page. There is no teaching or suggestion in this cited disclosure, of any type, regarding an imposed limit on the number of search results to be presented.

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<sup>3</sup> Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

Fields also fails to disclose or suggest the specific embodiments of the newly presented claims, and as recited, for example, in combination with the other recited claim elements. For instance, Fields clearly fails to teach or suggest any embodiment in which the search performed by the second application considers a profile of one or more users in performing the search (new claim 24), or wherein the search is performed *prior to* receiving any user input selecting the one or more search terms through the first application (new claim 25).

In view of the foregoing, and in view of the extensive and thorough prosecution of this case, Applicant respectfully submits that the application is now in immediate condition for allowance. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 17<sup>th</sup> of January, 2007.

Respectfully submitted,



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